

#### REMARKS

The *Office Action* has been received and reviewed. Sections 2-7 of the *Office Action* are the same as sections 1-6 of the office action dated January 9, 2006. Applicant has responded to these rejections in the response dated March 9, 2006. Applicant stands by that response. In response to sections 2-7 of the *Office Action*, applicant hereby incorporates the arguments made in the March 2006 response.

In the *Office Action*, several new arguments were made. The remainder of this response addresses those new arguments.

#### Section 12 Of The Office Action

At section 12 of the *Office Action*, it was argued that the application does not teach how a system would scan an electronic source document available on a network, without downloading the document onto the user's system and identifying types of reference entity information the system should scan for. There are at least two reasons this argument is untenable, and even if tenable, this argument can not be made in view of the references discussed in applicant's prior responses.

First, the argument is untenable because it is based on a misreading of the claims that assumes a document is not to be downloaded onto a user's system. The independent claims do not say anything about downloading the document onto the user's system. It is improper to base a rejection of the claims on a feature that is not in the claims. Therefore, the argument at section 12 of the *Office Action* must be withdrawn.

Second, the argument is untenable because it is based on a misreading of the claims that assumes there be no identification of types of reference entity information that the system should scan for. The independent claims do not say anything about the types of reference entity information. It is improper to base a rejection of the claims on a feature that is not in the claims. Therefore, the argument at section 12 of the *Office Action* must be withdrawn.

Further, in filing the *Request For Continued Examination*, applicant filed a response (the "July 2006 Response") that seems not to have been fully considered. In particular, applicant went to great lengths to describe Sotomayor and Barbic et al.. Applicant also provided the Berenci, Myers and Watson references, along with descriptions of the relevance of each reference. In the *Office Action*, there was no mention of these five references. It is respectfully requested that these five references, as well as arguments set forth in the July 2006 Response be given consideration. It is respectfully submitted that the arguments at section 12 can not be maintained in view of these five references.

Finally, in applicant's October 2005 response, applicant noted that Hedloy discloses a method of selecting contact information in which a document is analyzed to determine a referenced entity identified in the document. In response, the examiner stated that Hedloy discloses the matching of select pieces of information entered onto a document with a database of previously stored entity addresses/information. It is not clear from the examiner's statement why Hedloy does not undermine the arguments presented at section 12 of the *Office Action*. It is

respectfully requested that Hedloy and the arguments presented in applicant's October 2005 response be given due consideration.

Section 13 Of The Office Action

At section 13 of the *Office Action*, it was argued that it would not have been obvious to one having ordinary skill at the time the invention was made to know how to scan every letter/word/number of a networked document in order to determine an entity, and compare that entity to a stored database of entities. The independent claims do not require scanning every letter/word/number of a networked document. Instead, the independent claims require "analyzing an electronic source document available on a network of computers ...."

It appears that the misreading of the claims occurring in section 12 of the *Office Action* is related to the misreading of the claims occurring in section 13 of the *Office Action*. Specifically, the argument at section 13 of the *Office Action* is based on a misreading of the claims to require that a document not be downloaded onto a user's system. Therefore, the arguments set forth above with regard to section 12 are equally applicable to section 13.

As noted above, it is respectfully requested that Sotomayor, Barbic et al., Berenci, Myers, Watson and Hedloy be considered. The examiner is directed to the July 2006 Response and applicant's October 2005 response for details of these references and their relevance to this matter. The arguments at section 13 can not be maintained in view of these six references. In view

of these references it is requested that the arguments at section 13 be withdrawn.

Section 14 Of The Office Action

At section 14 of the *Office Action*, it was argued that "the features upon which applicant relies (i.e., examples from the specification) are not recited in the rejected claims". It was also argued in the *Office Action* that although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. The "features" to which the examiner refers are found at page 4, lines 1-3 of the application.

The arguments at section 14 of the *Office Action* are not responsive to the issue: the issue being whether the specification provides enough disclosure to enable one having skill in computers to practice the invention.

A bit of background is necessary to understand why the examiner's arguments are not responsive. In the applicant's responses, page 4, lines 1-3 of the application was identified. Applicant was responding to the examiner's argument that one having skill in the art would not have known (from reading the application and the prior art) how to analyze an electronic source document that is available on a network of computers to determine a referenced entity identified in the document. Applicant argued that page 4, lines 1-3 of the application describes a manner of causing a computer to analyze an electronic source document to determine a referenced entity identified in the document. Applicant also argued that via this portion of the

application, one having skill in the art of computers would know at least one manner of causing a computer to analyze an electronic source document to determine a referenced entity identified in the document.

Applicant did not ask to have limitations from the specification read into the claims. Furthermore, even if the limitations from the specification are read into the claims, it is not clear how that would be relevant to whether the specification enables one skilled in the art to practice the invention. Therefore, the comments at section 14 of the Office Action do not address the point applicant made.

At the end of section 14, there is a discussion of In re Van Geuns, 988 F.2d 1181 (Fed. Cir. 1993). It was stated in the Office Action that claims are interpreted in light of the specification, and limitations from the specification are not read into the claims. It is not clear why this is relevant to whether the specification complies with the enabling requirement of 35 U.S.C. 112, first paragraph. In re Van Geuns is a decision focused on 35 U.S.C. 103, not 112, and given the different standards under these sections of the statute, it is not clear how In re Van Geuns is relevant.

In In re Van Geuns, the claim included the phrase "uniform magnetic field". Van Geuns argued that the meaning of the phrase should be interpreted in light of the specification and the understanding of persons skilled in the NMR (Nuclear Magnetic Resonance) and MRI (Magnetic Resonance Imaging) art. Van Geuns' hope was that if interpreted in this manner, the claim would apply to NMR imaging, which requires a level of magnetic field

uniformity which he argued was not taught in the prior art. The court noted that the claim was not limited to NMR or MRI apparatus, and so the claim must be given its broadest reasonable interpretation. The court stated that limitations are not to be read into the claims from the specification, and so Van Geuns cannot read an NMR limitation into the claim to justify his argument as to the meaning of the phrase "uniform magnetic field."

Unlike Van Geuns, applicant has not asked that a limitation from the specification be read into the claims, nor would doing so address the 35 U.S.C. 112, first paragraph rejection. Therefore, In re Van Geuns is not relevant to the issue presented by the examiner, and is not responsive to the arguments applicant made with respect to page 4, lines 1-3 of the application.

CONCLUSION

In view of the foregoing remarks, it is respectfully submitted a full and complete response to the Office Action has been made. The claims are in condition for allowance, and allowance of the claims is respectfully requested.

The applicant believes that no fee is due with this Response. If a fee is due, please charge Deposit Account No. 08-2442. Further, applicant believes that no extension of time is necessary to file this Response. However, if an extension of time is needed, please consider this as a petition for an extension of time necessary to enter this Response.

The Examiner is invited to call applicant's attorney if any questions remain following review of this response. If it will

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help, the undersigned is willing to explain by telephone or in person, the reasons the claims are allowable.

Respectfully submitted,

  
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Date: November 27, 2006

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